

REMARKS

The present amendment is submitted in response to the Office Action dated March 24, 2004, which set a three-month period for response, making this amendment due by June 24, 2004.

Claims 13-23 are pending in this application.

In the Office Action, claims 4-5 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-11 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,311,946 to Pathmann. Claims 1-6 and 9-10 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,863,281 to Haydon et al. Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 355,729 to Stevens. Claim 1 stands further rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,664,754 to Brown. Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hayden in view of Brown.

In the present amendment, the specification has been amended to provide standard sectional headings and to delete reference to the claims.

Claims 1-12 have been canceled, and new claims 13-23 have been added. It is submitted that these new claims address the rejection of original claims 4-5 under Section 112, second paragraph. In particular, the Applicants note that due to a translation error from German into English, claim 4 recited inaccurate structure. Claim 4, in pertinent part, should have been translated to

read: ",and at least one detent projection (54) forms a detent toothing (57) with the at least one detent tooth (51) of the potentiometer housing (47)".

This corrected translation has been incorporated into new claim 13. New claim 13 essentially combines most of the features of original claims 1-4. New claim 14 defines that the at least one detent tooth is disposed on a periphery of the potentiometer housing (47). Support for this claim is found in Figure 2 and in the specification on page 3, lines 30-31. Claim 15 contains a feature of original claim 3 and also is shown in Figure 1. New claims 16 and 17 correspond to original claims 5 and 6, respectively. New claims 18 and 19 contain the features of original claims 8 and 7, respectively. New claim 20 corresponds with original claim 12, and new claim 21 with original claim 9. Finally, new claims 22 and 23 correspond to original claims 11 and 10, respectively.

The Applicants respectfully submit that none of the cited references discloses or suggests the present invention as defined in new claims 13-23. As disclosed in the specification on page 4, lines 5-17, after the potentiometer 25 is installed in the potentiometer housing 47, a certain home position of the pickup in relation to the loop of the potentiometer 25 should exist. The position of the driven wheel 30 is thereby specified by an external adjusting lever, and therefore, the position of the pickup of the potentiometer 25. To reach the home position, therefore, the motor 9 cannot be rotated in such a fashion that a home position is reached, because this would cause the driven wheel 30 to rotate. For this reason, the potentiometer housing 47 is arranged adjustably in the housing 5 of the control drive. The potentiometer housing 47 can therefore be rotated, while

overcoming the detent tooth 57, about an axis, which, as shown in Figure 1, for example, is perpendicular to the plane of the drawing. The housing of the potentiometer is rotated until a predetermined home position is reached. This can be a position of the potentiometer pickup at the beginning or the end or also a center position. In this manner, in an advantageous manner, production-induced tolerances of the potentiometer can be offset, in which a disadvantageous null or zero balance is performed.

Such an advantageous arrangement of a potentiometer in a control drive is neither shown nor suggested by any of the cited references.

The patent to Pathmann shows neither a potentiometer housing nor a detent tooth between a potentiometer housing and the housing 12 of the control drive. As can be seen from Figures 7 or 8 in Pathmann, for example, the potentiometer is secured to the floor of the housing 12 via the "wiper bus" 110 and corresponding rivets. In contrast, as discussed above, in the present invention the claimed detent toothing serves for attachment of the potentiometer housing 47 to the control drive housing 5. This should not be confused with a detent toothing of the drive shaft with the potentiometer, as shown in Pathmann.

Likewise, the patent to Haydon et al neither shows nor suggests the features of new independent claim 13. The potentiometer housing 16 of Haydon assembly has no detent tooth. In addition, no detent toothing between the potentiometer housing and the housing of the control drive is provided in Haydon. The housing 16 of the potentiometer in Haydon is connected via the end plate 13 and corresponding spacing bolts 14 with the housing 15. The possibility

detrimental rotating of the potentiometer housing relative to the driven wheel is not possible in the Haydon reference.

Because none of the cited reference discloses all of the features of new claim 13, claim 13 cannot be viewed as being anticipated by these references under Section 102. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Similarly, since none of the cited references suggests to the practitioner the features of the present invention as defined in claim 13, the present invention also is not obvious under Section 103 if the references were to be combined. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc., v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). Here, the prior art of record fails to provide any such suggestion or incentive.

For the reasons set forth above, the Applicants respectfully submit that new claims 13-23 are patentable over the cited art. The Applicants further request withdrawal of the rejections under 35 U.S.C. 102 and 103 and reconsideration of the claims as herein amended.

It has been noted that the Examiner did not consider the IDS filed February 21, 2002. Consideration of the IDS is respectfully requested.

In light of the foregoing amendments and arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,


Michael J. Striker
Attorney for Applicant
Reg. No.: 27233
103 East Neck Road
Huntington, New York 11743
631-549-4700